

### REMARKS

Claim 92 has been amended to recite an elastomeric masking system. Support for this amendment can be found in the specification, for example, on page 9, lines 18-21. Claim 96 has been correspondingly amended to provide proper antecedent basis.

Claims 51-62 and 91-100 are pending for examination.

#### Rejections under 35 U.S.C. §102(b) with respect to Harrison

The Patent Office has rejected claim 51 under 35 U.S.C. §102(b) as being anticipated by Harrison et al., U.S. Patent No. 5,948,470 ("Harrison").

Respectfully, the Applicants disagree with the Patent Office regarding the teachings of Harrison. Applicants believe that Harrison *necessarily* teaches that the mask must be degraded. Initially, it is believed that there may be confusion due to Harrison's use of the terminology "transferring" a pattern, of a degraded thin polymer film defining a mask, onto a substrate. In the context of Harrison, "transfer" means that the *pattern* of the mask (formed by a degradation process as discussed below) is used to guide etching in an underlying substrate. The mask of Harrison itself does not appear to be first formed, then transferred onto a substrate, then used for etching. For example, in the Summary of Invention (Col. 2, lines 25-40), Harrison teaches forming a pattern on a substrate using a block copolymer by: (1) selecting a block copolymer, (2) coating a thin film of the block copolymer onto a substrate, (3) *chemically altering and/or physically removing* a component of the block copolymer, and (4) transferring the *pattern* of the block copolymer onto a selected substrate (i.e., the pattern created in the block copolymer, not the copolymer itself). The transference of the pattern from the copolymer to the substrate, as seen in Col. 4, line 64 to Col. 5, line 5, includes etching processes that remove substrate material from the regions of the substrate aligned with regions of the block copolymer thin film from which some of the block copolymer *was removed*, such as reactive ion etching, ion milling, and wet chemical etching.

If portions of the block copolymer in Harrison were not removed, Harrison would fail of its intended purpose, as a pattern could not be transferred *through* the copolymer to the substrate, since the purpose of the block copolymer is to protect the underlying regions from the etching process. For instance, Harrison states that "For example, an etching process can be used to

remove substrate material beneath the region from which polymer was removed, *while leaving the material under the protected regions unaffected*” (Col. 4, line 66 to Col. 5, line 2) (emphasis added). Thus, Harrison teaches that the mask is necessarily degraded.

Accordingly, the Applicants respectfully disagree with the Patent Office’s position that the mask in Harrison is not degraded. It is not seen where in Harrison is there a disclosure or a suggestion of positioning a mask in conformal contact with a surface without degrading a portion of the mask proximate a second portion of the surface. Harrison therefore teaches away from claim 51, and it is thus respectfully requested that the rejection of claim 51 be withdrawn.

Rejections under 35 U.S.C. §103(a) with respect to Harrison

The Patent Office has rejected claims 52 and 91 under 35 U.S.C. §103(a) as being unpatentable over Harrison. The Patent Office states that “there is no hint of hindsight in this case, but rather simply obviousness to one of ordinary skill, Applicants failing to provide supporting evidence to the contrary.”

With all due respect, it is not the burden of the Applicants to prove that claim 52 is not obvious in view of the prior art. Rather, it is the burden of the Patent Office to provide a *prima facie* case of obviousness, which requires the Patent Office to provide supporting evidence. See MPEP §706.02(j). Absent any such evidence, such a rejection cannot be maintained by the Patent Office. Thus, Applicants respectfully request that the Patent Office provide support for such a position, or withdraw of the rejection of claims 52 and 91.

Rejections under 35 U.S.C. §103(a) with respect to Rustomji in view of Smith.

The Patent Office has rejected claims 92-100 under 35 U.S.C. §103(a) as being unpatentable over Rustomji, U.S. Patent No. 4,511,599 (“Rustomji”) in view of Smith, U.S. Patent No. 4,119,745 (“Smith”).

It is not seen in either Rustomji or Smith where there is a disclosure or a suggestion of an elastomeric mask, as is recited in claim 92, as amended, i.e., such that the mask is elastic. The claim now recites one specific embodiment of the invention, an elastomeric mask which inherently self-seals against a surface providing the ability for repeated use of the mask on different surfaces and application of an agent through channels defined in the masking system to

a surface with inhibition of leakage of the agent under the mask, i.e., between the mask and surface. The mask carries this inherent advantage without the application of auxiliary adhesive or the requirement of auxiliary forces to hold the mask in place, as is taught by each of the prior art references relied upon in this rejection.

Rustomji does not disclose a polymeric mask, let alone an elastomeric mask, and Smith only discloses that such masks may be plastics (col. 3, lines 24-43) and does not provide any disclosure or suggestion that the plastic mask can have elastic properties.

Even if any potential combination of these references were made, it is not believed that the mask as recited in the claims as amended would be met by the combination. The resulting combination would be a single or multi-part masking system either made of a rigid plastic which would require an auxiliary adhesive to hold the mask in place (it is a feature of the elastomeric mask of the invention as recited in the claims that stand rejected on this ground that the mask inherently has properties that result in conformal sealing of the mask against a surface), or a single or multi-part metal mask requiring a magnet to hold the mask adjacent a surface.

Accordingly, it is believed that claim 92, as amended, is not unpatentable over the combination of Rustomji in view of Smith, to the extent these references can be combined (which Applicants do not concede), and it is respectfully requested that the rejection be withdrawn. Claims 93-100 each depend, directly or indirectly, from claim 92, and are believed to be allowable for at least these reasons. Withdraw of the rejection of these claims is also respectfully requested.

Rejections under 35 U.S.C. §103(a) with respect to Rustomji in view of Smith and Allinikov

Claims 53-62 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Rustomji in view of Smith, and further in view of Allinikov, U.S. Patent No. 4,097,776 ("Allinikov").

While Applicants agree that cadmium oxide may be poisonous or carcinogenic (although the Patent Office has failed to provide a reference supporting its position), Applicants believe that one of ordinary skill in the art, upon reading the instant application, would not believe cadmium oxide to be a biological agent. Nearly any substance may have deleterious effects on a biological organism under certain conditions. Applicants believe that one of ordinary skill in the

art, in reading the instant application, would not interpret a "biological agent" to be any substance that could potentially affect a biological organism, but instead would understand that a biological agent is an agent that arises from a biological source. Examples of biological agents have been described in the specification. Thus, Applicants disagree with the Examiner's Official Notice that cadmium oxide is a biological agent.

Thus, to the extent that Rustomji, Smith and Allinikov can be combined (which Applicants do not concede), it is believed that such a combination would still not reach claims 53-62. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn.


### CONCLUSION

In view of the foregoing remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' representatives at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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